

REMARKS

Applicant has carefully reviewed the Office Action of October 8, 2004, and offers the following amendments and remarks in response thereto.

Applicant appreciates the telephonic interview of January 31, 2005. Where appropriate, comments therefrom are incorporated into the remarks presented below.

Before addressing the rejection, Applicant provides a brief summary of the present invention and summaries of the references cited by the Patent Office so that the remarks relating to the rejection are considered in the proper context.

As discussed during the telephonic interview, the present invention is designed to allow an individual that possesses multiple communication devices (such as a pager, a mobile telephone, a laptop, and the like) to create a profile that defines situations in which the individual should receive content on the multiple devices from a content provider. In particular, the individual indicates (through use of the profile) location criteria and event criteria. When a service provider detects an event occurrence that corresponds to the event criteria, and a location occurrence that corresponds to the location criteria, the service provider sends content to the multiple devices associated with the individual. It is relevant to note that a single user's profile causes the content (or, to use the language of the claims: information) to be sent to the multiple devices. Likewise, it is relevant to note that the user generally desires to receive the content, and thus assists in the preparation of the profile by defining what events and locations cause the provision of the content.

In contrast, Amin et al. discloses a system that functions around a push model (see generally, col. 3, lines 48-62). That is, in Amin et al., a user may provide certain demographic information, and this information is stored in the demographic database 80 (see col. 4, lines 3-28). Content providers pay the service provider to provide content to users that fit certain demographic criteria when they are within a certain distance of the content provider. For example, a pricey restaurant may pay the service provider to send the restaurant's menu to people that have indicated that they make more than \$50,000/year (see col. 1, lines 59-60 and col. 2, lines 6-12 and col. 4, lines 12-15). The system tracks the movement of the user to determine if the user is within a certain location (col. 3, lines 48-62). If the user is within the certain location and matches the criteria set forth by the content provider, the service provider pushes content to the user without the user having any control over the content provision.

Likewise, the content may be provided to multiple users, and by virtue thereof, to multiple devices. However, the provision of content to multiple devices is not the function of a single user-desired profile, nor is the content provided to multiple devices associated with a single user.

In further contrast, Lohtia et al. is a request driven system (see generally, col. 4, lines 25-41). That is, a user may wish to receive content on a wireless device, and to this end, the user requests predefined sets of information (see col. 4, lines 25-26). The user may define preferences about what sort of information is provided in a profile which is accessible through the web. The profile database may be accessible from and serve multiple wireless networks. However, it is relevant to note that the user actively requests information (see abstract). The background of Lohtia et al. contrasts this request from a push model that sends information at predetermined intervals (see col. 1, lines 30-35). Likewise, while a user may define a profile, there is no disclosure that Lohtia et al. teaches or suggests sending the information to multiple devices associated with a single user profile.

Claims 2-5, 11, 12, 14, 15, 18, 19, 21 and 22 were amended to provide proper antecedent basis for each of the claim elements in light of the previous amendments to the independent claims. No new matter is added, but the claims terms are now consistently recited throughout the claim set.

Claims 1-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. (hereinafter "Amin") in view of Lohtia et al. (hereinafter "Lohtia"). Applicant respectfully traverses. For the Patent Office to establish obviousness over a combination of references, the Patent Office must do several things. First, the references must be properly combinable. To determine if the references are properly combinable, the references must be considered in their entireties. MPEP § 2141.03. If some portion of the reference teaches away from the combination, then that is evidence of non-obviousness. *Id.* Further, there must be a motivation to combine the references, and this motivation must be supported by actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the motivation is properly supported with actual evidence, if the combination makes a reference unsuitable for its intended purpose, then, such a fact is evidence that the combination is non-obvious. MPEP § 2143.01. If the combination passes all these hurdles, then to establish *prima facie* obviousness, the combination must still teach or suggest all the claim elements. MPEP § 2143.03. If the Patent Office cannot establish obviousness, then the claim is allowable.

As explained above, Amin is a push model. Push models, by definition, push content to users regardless of whether the users desire the content or not. Even in those places where Amin contemplates a request from a user, the actual content provided in response thereto is dictated by the service providers (see Amin, col. 4, lines 38-41). In contrast, Lohtia teaches a request driven model. Lohtia requires the user to dial a content provision number or invoke a Short Message System (SMS) origination request. Thus, Amin teaches away from a combination with Lohtia because the combination moves away from the push model of Amin. By advancing the combination of Amin and Lohtia, the Patent Office is ignoring the portions of Amin which teach away from the combination. Ignoring these portions of Amin is impermissible, because the references must be considered in their entirety, even those portions that teach away from the combination. MPEP § 2141.03.

Applicant further traverses the rejection because the Patent Office has not provided a proper motivation to combine the references. For claim 1, the Patent Office opines it would have been obvious to combine the teachings of Lohtia with the system of Amin so "users may received any desired information based on time or predetermined times, location and event triggers that outlines when certain types of information are to be delivered through a plurality of communication devices." The motivations advanced for the other independent claims are substantially identical. However, this motivation does not compel the combination. Applicant notes that Lohtia has location triggers (see Lohtia, col. 5, line 30). To this extent, the motivation advanced by the Patent Office is fulfilled by Lohtia alone. As such, there is no need to combine Lohtia with Amin. Since the motivation does not compel the combination, the motivation is improper. Since the motivation is improper, the references must be considered individually. The Patent Office admits that Amin does not teach or suggest all the claim elements. Likewise, the Patent Office has not articulated where in Lohtia all the claim elements are taught or suggested. Since the references individually do not teach or suggest all the claim elements, the references do not establish obviousness. Since the combination is improper, and the references individually do not establish obviousness, all the claims are non-obvious over the rejection of record.

Even if the motivation does suggest the combination, a point which Applicant does not concede, the motivation is not properly supported by the requisite actual evidence. Applicant has previously quoted the motivation provided for claim 1 and noted that the motivations provided for the other independent claims are similar. In each case, the Patent Office has not provided any

evidence to support the motivation. While the Federal Circuit has acknowledged that there are multiple sources of evidence, the Federal Circuit went on to say that the range of sources available **does not diminish the requirement for actual evidence**. *Dembiczak* at 999 (emphasis added). Applicant notes that there are a number of other motivations dispersed throughout the dependent claims (such as in the analysis of claims 2-3, 18-19, and 21-22). In each case, there is no evidence to support any of the proffered motivations. Since the motivations are not properly supported with the required actual evidence, the motivations are improper. Since the motivations are improper, the combinations are improper. As explained above, since the combinations are improper, and the references individually do not establish obviousness, all the claims are non-obvious over the rejection of record.

Even if the motivation is proper, a point which Applicant does not concede, the combination renders Lohtia unsuitable for its intended purpose, and thus, the combination is improper. As noted above, Lohtia is a request driven model. Combining Lohtia's profile with Amin's push model renders Lohtia unsuitable for the provision of information based on a request sent from the user. Since the combination renders Lohtia unsuitable for its intended purpose, the combination is improper. As explained above, since the combination is improper, and the references individually do not establish obviousness, all the claims are non-obvious over the rejection of record.

Even if the combination is proper, a point which Applicant does not concede, the combination does not establish obviousness. As discussed during the telephonic interview, claims 1 and 17 recite that the information is sent to a plurality of communication devices when the event occurrence and location indicia correlate with an event criteria and location criteria defined in a user-desired profile (emphasis added). Thus, the sending of the information to a plurality of devices occurs based on a single profile. In the Office Action, the Patent Office does not identify where in either reference this element is taught. The Patent Office does indicate that Lohtia's profile database may serve one or more wireless networks, but there is no indication that a plurality of devices are sent information when the detected criteria match criteria set forth in a single user's profile. Applicant explained this distinction during the telephonic interview, and the Examiner requested that this argument be included in the response for further consideration. Applicant herein does so. The combination of references does not teach or suggest a single user profile causing the provision of information to a plurality of communication devices. Thus, even

in combination, the references do not teach or suggest all the claim elements for claims 1-19, and claims 1-19 are allowable.

Applicant requests reconsideration of the rejection for the reasons outlined herein. The combination is improper, and further, the combination does not establish obviousness. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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